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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,880	12/03/2003	Robert T. Streeter	027298-9088	5394
23409 7590 07/26/2007 MICHAEL BEST & FRIEDRICH, LLP 100 E WISCONSIN AVENUE Suite 3300 MILWAUKEE, WI 53202			EXAMINER KIM, CHONG HWA	
			ART UNIT 2167	PAPER NUMBER
			MAIL DATE 07/26/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/726,880	Applicant(s) STREETER ET AL.	
	Examiner Chong H. Kim	Art Unit 2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,7-10 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,7-10 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Note: Claim 9 depends from claim 3 which has been canceled by the applicant. Therefore, claim 9 is assumed to be depended from claim 1. Correction is required in response to the present Office action.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 5, and 7-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites the newly included subject matter “the feed slot extending axially and radially inwardly from the bearing inner surface.” It appears that such configuration is neither shown in the drawings nor disclosed in the specification as originally filed. The inner surface of the bearing appears to be smooth and does not contain any protruding slot extending therefrom.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 2167

4. Claims 1, 5, and 7-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the pressure lube feed port" in lines 19-20. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 5, 7-10, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Edison, U.S. Patent 1,013,869.

Edison shows, in Figs. 1 and 2, a lubricant circulation system and a lubricant circulation method for a shaft that rotates in a bearing, the system and the method comprising;

providing a bearing 3 having an inner surface and being disposed on the shaft 8 so as to define a clearance between the shaft outer surface and the bearing inner surface (inherent);

providing an oil ring 7 configured to draw lubricant from a lubricant source 18 and to deliver the lubricant to the clearance;

providing an oil ring slot (between the right side bearing and the left side bearing) formed in the bearing for accommodating the ring, a portion of the oil ring extending through the slot in contact with the shaft;

providing and a conduit 17 connected to the clearance for receiving lubricant from the clearance and delivering the lubricant back to the lubricant source, the conduit having an outlet disposeable within the lubricant source such that the conduit delivers the lubricant from the clearance to a lower portion of the lubricant source;

providing a radially extending port 16 formed through the bearing and connecting the clearance and the conduit;

providing a lubricant feed slot 15 formed in the bearing for collecting a portion of the lubricant drawn from the lubricant source, the feed slot extending axially and radially inwardly from the bearing inner surface so as to be fluidly connected with an axial section of the clearance, the feed slot extending generally axially from the oil ring slot and being angularly spaced from the pressure lube feed port such that a portion of a circulation path extends from the oil ring axially through the feed slot, circumferentially through the clearance, and through the port to the conduit;

wherein the lubricant in the clearance is transferred to the conduit by the pressure differential between the clearance and the conduit; wherein a portion of the lubricant drawn from the lubricant source follows a closed-loop circulation path; wherein the closed-loop circulation path is defined from the lubricant source, to the oil ring, through the clearance, through the conduit, and back to the lubricant source; and wherein the lubricant source is an oil sump.

Response to Arguments

7. In response to the applicant's argument that Edison fails to show the "conduit having an outlet disposeable within the lubricant source such that the conduit delivers the lubricant from

Art Unit: 2167

the clearance to a lower portion of the lubricant source,” it is the Examiner’s view that such configuration is anticipated by Edison. The language “disposeable” is considered a functional language and therefore is not given patentable weight. However, even if the functional language is given the patentable weight, Edison shows that the outlet of the conduit 17 is disposeable within the lubricant source (the sump 18) and configured to deliver the lubricant to the lower portion of the sump. It is reminded that the lubricant source is not interpreted to be the liquid *a*, but the reservoir or sump 18.

8. In response to the applicant’s argument that Edison fails to show the “feed slot extending axially and radially inwardly from the bearing inner surface,” it is the Examiner’s view that such configuration is considered a new matter as discussed above.

9. In response to the applicant’s argument regarding the subject matter of a “closed-loop” and a “open-loop”, it is Examiner’s view that the circulation as disclosed by Edison is a “closed-loop”. It is not clear what the applicant’s argument is regarding the type of circulation. Is the closed-loop must have some sort of “closed” passage in order to be considered a “closed-loop”. Or does the lubricant must not have some sort of “break” in order to be considered a “closed-loop”. As far as the circulation is concerned, it is the Examiner’s view that the circulation as disclosed by Edison is “closed-loop” in the sense that the lubricant in the sump 18 is continuously circulated via the ring, the clearance, and the outlet.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chong H. Kim whose telephone number is (571) 272-7108. The examiner can normally be reached on Monday - Friday; 9:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2167

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

chk
July 23, 2007



CHONG H. KIM
PRIMARY EXAMINER